

REMARKS

Claims 1-17 and 25-29 are pending in the Application. Claims 1-17 and 25-29 are rejected. Claims 1-6, 9-11, 13-17 and 25-29 are rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Morman (U.S. Patent No. 5,336,545). Claims 7, 8 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Morman in view of Haffner et al. (U.S. Patent No. 5,789,065).

Independent claim 1 and claims 2-6, 9-11, and 13-17 depending from claim 1 are drawn to a tear resistant laminate comprising a laminate having an ultimate force to break of at least 3000 g/in in the transverse direction. Although Morman fails to explicitly disclose a laminate having the claimed force to break properties, the claims are rejected on the assertion that the force to break properties would be inherent in the Morman laminate, because the materials and the laminate layers of the Morman laminate are similar to the materials and laminate layers described in the present Application. The rejection acknowledges the differences in the processing steps between the Morman laminate and the present Application; however, the rejection asserts that the burden is on the Applicant to show through evidence that the processing steps of Morman do not yield a laminate that meets the claimed force to break properties. The Applicant respectfully submits that the burden of proof has not shifted to the Applicant, because the rejection does not establish a *prima facie* case of anticipation based on inherency.

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The basis for inherency in rejecting claims 1-6, 9-11 and 13-17, as noted above, is that the materials and the laminate layers of the Morman laminate are similar to the materials and laminate layers described in the present Application despite the differences in processing.

Independent claim 25, as amended, requires a non-woven and elastic polymeric film laminate having a first nonwoven web that “has been substantially permanently set in a transversely consolidated state before being bonded to the elastic polymeric film.” The first

nonwoven web is substantially permanently set in a transversely consolidated state, because it is heated a temperature between its softening temperature and melting temperature, transversely consolidating the web, then cooled. Thus, the first nonwoven web will not substantially return to a transversely unconsolidated state. In contrast, the nonwoven web in Morman is not heated or cooled during stretching and is only temporarily transversely consolidated, because if not tensioned it would return to a substantially unconsolidated state. Accordingly, Morman does not disclose each and every limitation of claim 25, because it fails to disclose a first non-woven web that "has been substantially permanently set in a transversely consolidated state before being bonded to the elastic polymeric film." Applicant, therefore, respectfully requests withdrawal of the rejection to claim 25 under 35 U.S.C. § 102(b).

It would not be obvious to modify Morman to meet the limitations of claim 25, because Morman teaches away from providing a non-woven web that "has been substantially permanently set in a transversely consolidated state before being bonded to the elastic polymeric film," in teaching that the roller speed be adjusted to maintain the web in a tensioned, necked condition when joined to the elastic layer (col. 5, lines 40-47). It would be unnecessary to tension a web that is already substantially permanently set in the consolidated state. Accordingly, Applicant respectfully requests withdrawal of the rejection to claim 25 under 35 U.S.C. § 103(a).

In paragraph 8 of the Office Action the Examiner states the the features of Applicant's invention upon which Applicant relies to distinguish over the prior art are not recited in the rejected claim(s). The Examiner has apparently misunderstood Applicant's previous arguments. Applicant is arguing that the claims are distinguishable over the prior art based only upon the limitations that are present in the claims, for example a laminate having an ultimate force to break of at least 3000 g/in. Applicant's arguments regarding process steps are directed to establishing that the Examiner cannot make a *prima facie* case that the prior art laminate has an ultimate force to break of at least 3000 g/in. (along with the other claimed limitations) because it is not made the same way as Applicant's laminate.

Applicant : Stephen D. Bruce et al.
Serial No. : 09/491,721
Filed : January 27, 2000
Page : 9 of 9

Attorney's Docket No.: 15838-211001 / 233USPT

Claims 26-29 depend from independent claim 25 and Applicant respectfully requests withdrawal of the rejections of claims 26-29 under 35 U.S.C. § 102(b) and § 103(a) for at least the same reasons as claim 25.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: September 8, 2003

P. Weston Musselman, Jr.
P. Weston Musselman, Jr.
Reg. No. 31,644

Fish & Richardson P.C.
5000 Bank One Center
1717 Main Street
Dallas, Texas 75201
Telephone: (214) 292-4030
Facsimile: (214) 747-2091